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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,571	12/19/2001	Moses V. Chao	CHAO=11A	9320
1444 7590 02/19/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER CHERNYSHEV, OLGA N				
ART UNIT 1649		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/021,571

Applicant(s)

CHAO ET AL.

Examiner

Olga N. Chernyshev

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claim 1 has been amended and claims 5 and 7 have been cancelled as requested in the amendment filed on October 11, 2007. Following the amendment, claims 1-4 and 6 are pending in the instant application.

Claims 1-4 and 6 are under examination in the instant office action.

2. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

3. Applicant's arguments filed on October 11, 2007 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-4 and 6 stand rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial credible asserted utility or a well-established utility for reasons of record fully explained in section 5 of Paper mailed on May 11, 2007.

Applicant traverses the rejections on the grounds that "ARMS co-localizes with VAMP-2 and can be used for the same purpose as VAMP-2, e.g., as a marker for growth cones and synaptic regions of neurons" (bottom at p. 4 of the Response). Applicant further refers to the website, which offers antibodies to VAMP-2, and to Fig. 18 presenting a picture of neuronal cultures stained for the presence of ARMS protein by using anti-ARMS fluorescent antibody (p.

5 of the Response). Applicant then concludes that "the instant specification does indeed disclose a specific, substantial, credible utility for the ARMS protein of the present invention" (bottom at p. 5). The Examiner disagrees.

The employment of proteins of the instant invention, ARMS of SEQ ID NO: 2 (rat) or ARMS of SEQ ID NO: 4 (human), as tissue specific markers is not a substantial or specific utility. All human proteins can invariably be classified into two categories, those which are expressed in a tissue or developmentally specific manner and those which are expressed ubiquitously. It can be alleged that any protein which is expressed in a tissue specific manner can be employed to detect the tissue in which it is expressed in a sample. Alternately, a human protein which is expressed ubiquitously can be employed to detect the presence of any human tissue in a sample. Such utilities are analogous to the assertion that a particular protein can be employed as a molecular weight marker, which is neither a specific or substantial utility.

One could just as readily argue that any purified compound having a known structure could be employed as an analytical standard in such processes as nuclear magnetic resonance, infrared spectroscopy, and mass spectroscopy as well as in polyacrylamide gel electrophoresis (PAGE), HPLC and gas chromatography. None of these processes could be practiced without either calibration standards having known molecular structures or, at least, a range of molecular weight markers having known molecular weights. One could further extrapolate upon this premise by asserting that any item having a fixed measurable parameter can be employed to calibrate any machine or process which measures that parameter. For example, any item having a constant mass within an acceptable range can be employed to calibrate a produce scale in a grocery store. The calibration of produce scales is certainly an important function since most

Art Unit: 1649

states require produce scales to be calibrated and certified. Therefore, to accept Applicant's arguments that any protein of human or animal origin is useful as a marker would be comparable to conceding that any object of fixed mass has *prima facie* utility as a weight standard, irrespective of any other properties possessed by that object. It was just such applications that the court appeared to be referring to when it expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation (*Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966)). Because the steroid compound which was the subject of that decision had a known structure and molecular weight it could have readily been employed as a molecular standard at that time. Further, because that compound was a hydrocarbon it certainly could have been employed in the well known process of combustion for purposes of lighting and/ or the generation of heat. The generation of heat by combustion of hydrocarbons certainly was and remains an important process. Irrespective of such obvious utilities, the court still held that the compound produced by the process at issue in *Brenner v. Manson* did not have a specific and substantial utility.

To grant Applicant a patent encompassing isolated naturally occurring human and rat proteins, which are not readily usable in their current form, would be to grant Applicant a monopoly "the metes and bounds" of which "are not capable of precise delineation". That monopoly "may engross a vast, unknown, and perhaps unknowable area" and "confer power to block off whole areas of scientific development, without compensating benefit to the public" (*Brenner v. Manson, Ibid*). To grant Applicant a patent on the claimed polypeptides based solely upon an assertion that these proteins can be employed as tissue markers is clearly prohibited by this judicial precedent since the compensation to the public is not commensurate with the

monopoly granted and would be no different than granting a patent on the process disputed in *Brenner v. Manson* on the premise that the steroid produced thereby was useful as an analytical standard or as a fuel source.

Since by Applicant's own admission, the utility of the instant polypeptide ARMS of SEQ ID NO: 2 and ARMS of SEQ ID NO: 4 is for tissue staining and is based on the utility of VAMP-2 proteins, which also could be used for the same purpose, then the utility of the instant polypeptides is clearly not specific. It is also not substantial because any protein, which is expressed in neuronal cells could be used for the same purpose with the equal level of success.

Thus, for reasons of record in the previous office action of record and reasons above, the instant rejection is maintained.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-4 and 6 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.
8. Claims 1, 4 and 6 are further rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention for reasons of record in section 8 of Paper mailed on May 11, 2007.

Claims 1, 4 and 6, as amended, are directed to polypeptides, which are fragments of the polypeptides of SEQ ID NO: 2 or SEQ ID NO: 4. At pp. 5-6 of the Response, Applicant submits that deletion of recitation of “functional derivatives” obviates this ground of rejection. However, the rejection of record specifically addressed the limitation “fragments” of polypeptides and explained why the claimed genus of fragments is not adequately described. Applicant is advised that defining fragments as “comprising the N-terminal ankyrin repeat” does not render the claimed molecules sufficiently described. Firstly, the metes and bounds of the structural limitations are not clear, see section 11 of the instant office action; secondly, the instant recited fragments are claimed using “comprising” language, which broadly encompasses any polypeptide, wherein a fragment of undefined structure is embedded. The Examiner maintains that the instant specification fails to provide the written description of the genus of the fragments, which are part of SEQ ID NO: 2 or SEQ ID NO: 4, comprise “the N-terminal ankyrin repeat” and have any relevance to the ARMS proteins of the instant invention.

New grounds of rejection necessitated by amendment

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 is vague and ambiguous for recitation “the N-terminal ankyrin repeat”. Because the instant specification fails to delineate what is included or excluded in the structure of “N-terminal ankyrin repeat”, the metes and bounds of the structural characteristics of the claimed molecules cannot be determined from the claim or the instant specification, as filed.

12. Claims 2, 3, 4 and 6 are indefinite for being dependent from indefinite claims.

Conclusion

13. No claim is allowed.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey J. Stucker can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 13, 2008

/Olga N. Chernyshev, Ph.D./

Primary Examiner, Art Unit 1649